

### **REMARKS**

This paper responds to the Office Action mailed on April 19, 2007. Claim 7 is amended such that claims 7-9, 11-20, 26-28 and 31 are now pending in this application.

#### **Claim Objections**

Claims 11 and 12 were objected to because of improper dependency. Applicants have amended claim 11 in order to address the Examiner's objection.

#### **First §102 Rejection of the Claims**

Claims 7-9 and 11-12 were rejected under 35 U.S.C. § 102(e) for anticipation by Chalek (US 6,936,018). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* '2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As part of making the rejection, the Examiner states at page 2 of the Final Office Action that "Regarding claim 7, Chalek discloses . . . wherein each of said plurality of fingers is integral with the elastic band (Fig 1, column 5 lines 18-19)." Applicants respectfully traverse the assertion because the portions of Chalek that are cited by the Examiner show that the attachment elements 26 are "affixed to the distal end 24" of the strip 12.

Applicants further note that the FIGS. of Chalek show that the attachment elements 26 are part of a separate layer from the strip 12. Therefore, Chalek does not describe "wherein the elastic band and the plurality of fingers are formed as part of a single layer such that each of said plurality of fingers is integral with said elastic band" as recited in amended claim 7. Claims 8-9 and 11-12 depend from claim 7, and are patentable over Chalek for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 7-9 and 11-12 are respectfully requested.

Second §102 Rejection of the Claims

Claims 26-28 and 31 were rejected under 35 U.S.C. § 102(b) for anticipation by Peterson (US 5,538,500). As part of making the rejection, the Examiner states at page 3 of the Final Office Action that “Regarding claim 26, Peterson discloses . . . attaching one end of an elastic band to skin on the body using an adhesive (28, Fig 1).” Applicants respectfully traverses the assertion.

Applicants can not find any teaching or suggestion in Peterson that one end 16 of the disclosed bandage wrap 12 is attached to the body using an adhesive while the opposing end 18 of the bandage wrap 12 is attached to an exposed section of the bandage wrap 12. Applicants note that tape 28 in Peterson is only described as being in the wound-covering section 14 of the bandage wrap 12, which is not on either end of the bandage wrap 12 (see Fig. 1 and col. 4, line 66 through col. 5, line 18 of Peterson).

Therefore, Peterson does not describe “attaching one end of an elastic band to skin on the body using an adhesive” in combination with “securing a plurality of fingers that project from an opposing end of the elastic band to an exposed section of the elastic band” as recited in amended claim 26. Claims 27-28 and 31 depend from claim 26, and are patentable over Peterson for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 26-28 and 31 are respectfully requested.

Applicants’ Comments on Examiner’s Response to Arguments

The Examiner states at page 9 of the Final Office Action that “Applicant’s argument regarding claims 26-28 and 31 is not found persuasive because the claimed method is anticipated by the normal use of the wrap as disclosed by Peterson, as described above.” Applicants respectfully traverse the assertion because as discussed above, Applicants can not find any teaching or suggestion in Peterson that one end of the disclosed bandage wrap is attached to the body using an adhesive while the opposing end of the bandage wrap is attached to an exposed section of the bandage wrap. Applicants again note that tape in Peterson is only described as being in the wound-covering section 14 of the bandage wrap 12 (i.e., not on either end of the bandage wrap).

First §103 Rejection of the Claims

Claims 13 and 15-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson. To sustain a rejection under 35 U.S.C. 103, references must be cited that teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02.

Claim 13

Applicants respectfully traverse the rejection of claim 13 because Peterson does not describe each and every element of the claimed invention. As discussed above, Applicants can not find any teaching or suggestion in Peterson that one end 16 of the disclosed bandage wrap 12 is attached to the body using an adhesive while the opposing end 18 of the bandage wrap 12 is attached to an exposed section of the bandage wrap 12. Applicants note that the tape 28 in Peterson is only described as being in the wound-covering section 14 of the bandage wrap 12, which is not on either end of the bandage wrap 12 (see Fig. 1 and col. 4, line 66 through col. 5, line 18 of Peterson).

Therefore, Peterson does not describe “an adhesive layer mounted on said elastic band near said first end to secure said elastic band to a body, wherein said adhesive layer is adapted to be detachably mounted to skin on the body” in combination with “a plurality of fingers extending from said second end of said elastic band” as recited in claim 13. The Examiner appears to acknowledge this at page 5 of the Final Office Action by stating “Peterson does not disclose having the adhesive layer near the first end.”

The Examiner attempts to overcome the acknowledged deficiencies of Peterson by stating at page 8 of the Office Action that

“it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive at an end of the elastic band in order to secure the flexible wrap to the skin at an end of the wrap instead of in the middle. . .”

Applicants respectfully traverse these assertions in part because Peterson does not teach or suggest an adhesive layer mounted on an end of the elastic band to secure the elastic band to a body. Applicants respectfully submit that the statements made by the Examiner regarding a motivation to modify Peterson are mere conclusory statements of subjective belief because the statements are analogous to the unsatisfactory statements made by the Examiner and board in *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

"With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that 'the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software' and that 'another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial' do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use '[use] that which the inventor taught against its teacher.' *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)." *Lee*, at 1343, 1344."

Applicants respectfully note that the Examiner provides no support for the assertions relating to modifying Peterson which were made in the Office Action. Applicants respectfully submit that the only teaching or suggestion relating to a flexible wrap as recited in claim 13 is found in Applicants' disclosure.

Applicants also respectfully traverse the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements in the claims are found in Peterson. Applicants respectfully request that the Examiner cite with particularity where each of elements in claim 13 are found in Peterson.

If the Examiner does not cite with particularity where each of elements in claim 13 are found in Peterson, Applicants will assume that the Examiner is taking official notice of the

missing elements. Applicants respectfully object to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicants respectfully traverse the assertion of Official Notice and request that the Examiner cite references in support of this position.

Reconsideration and allowance of claim 13 are respectfully requested.

*Applicants' Comments on Examiner's Response to Arguments*

The Examiner states at page 9 of the Final Office Action that “The claim states that the adhesive of Peterson “is not on either end of the bandage wrap.” The claims states that the adhesive layer is “near said first end.” In response to Applicant’s argument that the references fail to show certain features of Applicants’ invention, it is noted that the features upon which Applicants relies (i.e., the adhesive layer mounted on an end of the wrap) are not recited in the rejected claim(s).” Applicants respectfully traverse the assertion because Applicants is relying on language recited in claim 13 (i. e., “an adhesive layer mounted on said elastic band near said first end”). As discussed above, the Examiner has acknowledged at page 5 of the Final Office Action that “Peterson does not disclose having the adhesive layer near the first end.” Since Peterson does not teach or suggest all of the claim elements, Applicants respectfully submit that the rejection should be withdrawn.

*Claims 15-19*

Applicants respectfully traverse the rejection of claims 15-19 because Peterson does not describe each and every element of the claimed invention. Applicants can not find any teaching or suggestion in Peterson as to a fastener that extends along a midsection of a pack such that the fastener secures the pack to an elastic band. Applicants note that Peterson only describes attaching the absorbent pad 24 to the bandage wrap 12 about the absorbent pad’s 24 circumference or sides (see Peterson at col. 4, lines 15-18).

Therefore, Peterson does not describe “a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band” as recited in claim 15. The Examiner appears to acknowledge this at page 5 of the Final Office Action by stating “Peterson

does not disclose a fastener along the midsection of the pack, but does teach that the pack need not be secured to the wrap entirely around its circumference (column 4 lines 15-17).”

The Examiner attempts to overcome the acknowledged deficiencies of Peterson by stating at pages 5-6 of the Final Office Action that:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the manufacturing of the invention.”

Applicants respectfully traverse these assertions in part because Peterson does not teach or suggest a fastener on a midsection of a pack. Applicants respectfully submit that the statements made by the Examiner regarding a motivation to modify Peterson are again mere conclusory statements of subjective belief because the statements are analogous to the unsatisfactory statements made by the Examiner and board in *In re Lee* (see quote from *Lee* case above).

Applicants respectfully note that the Examiner provides no support for the assertions relating to modifying Peterson which were made in the Final Office Action. Applicants respectfully submit that the only teaching or suggestion relating to a flexible wrap as recited in claim 15 is found in Applicants’ disclosure.

Applicants also respectfully traverse the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements in the claims are found in Peterson. Applicants respectfully request that the Examiner cite with particularity where each of elements in claim 15 are found in Peterson.

If the Examiner does not cite with particularity where each of elements in claim 15 are found in Peterson, Applicants will assume that the Examiner is taking official notice of the missing elements. Applicants respectfully object to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicants respectfully traverse the assertion of Official Notice and request that the Examiner cite references in support of this position.

The Examiner further states at page 6 of the Office Action that

“it would have been an obvious matter of design choice to a person of ordinary skill in the art to place the fastener along the midsection of the pack because

Applicants has not disclosed that placing the fastener along the midsection of the pack is critical to the invention. One of ordinary skill in the art would have expected Applicant's invention to perform equally well with either the fastener along the edges (as the invention disclosed by Peterson) or the fastener along the midsection of the pack".

Applicants respectfully traverse this assertion and direct the Examiner's attention Applicants' specification at page 3, lines 22-29 and page 10, lines 25-32. These portions of Applicants' specification identify that positioning the adhesive layer on the midsection of the pack, and orienting the adhesive layer transverse to the lateral edges of the elastic band, minimizes the stress that is generated on the joint between the elastic band and the adhesive layer when the elastic band is stretched as part of being wrapped around the body. The location and orientation of the adhesive layer relative to the elastic band and the pack allows the pack to be reliably secured to the elastic band without using a pocket formed on the elastic band.

The Examiner further acknowledges at page 9 of the Office Action with regard to claim 17 that Peterson does not disclose a single adhesive layer that extends along the midsection of the pack. Applicants agree and again note that Peterson only describes attaching the absorbent pad 24 to the bandage wrap 12 about the absorbent pad's 24 circumference or sides (see Peterson at col. 4, lines 15-18).

The Examiner attempts to overcome the acknowledged deficiencies of Peterson by stating at page 9 of the Office Action that:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the of manufacturing the invention."

Applicants respectfully submit that the statements made by the Examiner regarding a motivation to modify Peterson are again mere conclusory statements of subjective belief because the statements are analogous to the unsatisfactory statements made by the Examiner and board in *In re Lee* (see quote from *Lee* case above). Applicants respectfully note that the Examiner provides no support for these assertions that were made in the Office Action which is related to modifying Peterson.

Reconsideration and allowance of claims 15-19 are respectfully requested.

*Second §103 Rejection of the Claims*

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson as applied to claim 13 above, and further in view of Daneshvar (US 2003/014938A1). Applicants respectfully traverse the rejection because the combination of Peterson and Daneshvar does not describe each and every element of the claimed invention.

As discussed above, Peterson does not teach or suggest “an adhesive layer mounted on said elastic band near said first end to secure said elastic band to a body, wherein said adhesive layer is adapted to be detachably mounted to skin on the body” in combination with “a plurality of fingers extending from said second end of said elastic band” as recited in claim 13.

Applicants note that Daneshvar also does not describe these limitations.

Claim 14 depends from claim 13 and as such incorporates all of the limitations of claim 13. Therefore, Applicants respectfully submit that the combination of Peterson and Daneshvar does not teach or suggest a flexible wrap as recited in claim 14.

Reconsideration and allowance of claim 14 are respectfully requested.

*Third §103 Rejection of the Claims*

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson as applied to claim 16 above, and further in view of Hymes (US 6,455,065) and Podell et al. (US 5,620,702). Applicants respectfully traverse the rejection because the combination of Peterson with Hymes and Podell does not describe each and every element of the claimed invention.

As discussed above, Peterson does not teach or suggest “a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band” as recited in claim 15. Applicants note that Hymes and Podell also do not describe “a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band” as recited in claim 15.

Claim 20 depends from claim 15 and as such incorporates all of the limitations of claim 15. Therefore, Applicants respectfully submit that the combination of Peterson with Hymes and Podell does not teach or suggest a flexible wrap as recited in claim 20.



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Reconsideration and allowance of claim 20 are respectfully requested.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record is relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

RICKY W. PURCELL ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(262) 646-7009

Date May 7, 2007

By / Andrew Peret /  
Andrew R. Peret  
Reg. No. 41,246

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7<sup>th</sup> day of May 2007.

JONATHAN FERANSON

Name

Jonathan Ferguson

Signature